UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/780,742	02/09/2001	Brian Viscount	1091	6942

7590 05/20/2004	EXAMINER
IRA J. SCHAEFER	NGUYEN, HAI V
HOGAN & HARTSON LLP	

ART UNIT	PAPER NUMBER
2142	

875 THIRD AVENUE
NEW YORK, NY 10022

DATE MAILED: 05/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

Office Action Summary	Application No. 09/780,742	Applicant(s) VISCOUNT ET AL.
	Examiner Hai V. Nguyen	Art Unit 2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>03</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 February 2001*.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18* is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *1-18* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: _____.

DETAILED ACTION

1.   This Office Action is in response to the application filed on 09 February 2001.

2.   Claims 1-18 are presented for examination.

Claim Rejections - 35 USC § 112

3.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4.   Claims 1, 7, 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5.   Claims 1, 7, 13 recite the limitation "providing ... for diagnosing the operation of the device" in claims 1, 7, 13. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

6.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102(e) that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7.   Claims 1-18 are rejected under 35 U.S.C. 102(e) as being anticipated by

Lightner et al. US patent no. **6,636,790 B1**.

8.   As to claim 1, Lightner teaches substantially the invention as claimed, including a

method for servicing a wireless data collection device *(Fig. 2, item 35)*, comprising the

steps of:

providing a diagnostic program in the wireless data collection device for

diagnosing the operation of the device *(diagnosing or collecting a performance or status*

of a component of the vehicle, Abstract, col. 2, lines 40-65; col. 3, lines 6-58);

receiving a request to service the device remotely initiating the diagnostic

program using a communications protocol over a network *(Abstract, col. 2, lines 40-65;*

col. 3, lines 6-58; col. 4, line 59 – col. 4, line 46);

communicating outputs from the diagnostic program using the communications

protocol to the network *(Abstract, col. 2, lines 40-65; col. 3, lines 6-58; col. 3, line 59 –*

col. 4, line 46; col. 4, line 47 – col. 5, line 5); and

providing servicing information to a user of the device based upon the outputs

from the diagnostic program *(Abstract, col. 2, lines 40-65; col. 3, lines 6-58; col. 3, line*

59 – col. 4, line 46; col. 4, line 47 – col. 5, line 5).

9.   As to claim 2, Lightner teaches, wherein the network is the Internet *(col. 3, lines*

50-58).

10.   As to claim 3, Lightner teaches, wherein the information is provided over the

network *(col. 3, lines 50-58)*.

11.   As to claim 4, Lightner teaches, wherein the request to service is received over

the network *(col. 3, lines 50-58)*.

12.   As to claim 5, Lightner teaches, wherein the device is a scanning terminal

(collector).

13.   As to claim 6, Lightner teaches, wherein the device is an integrated scanning

terminal *(collector)*.

14.   As to claim 7, Lightner teaches a method for reconfiguring a wireless data

collection device, comprising the steps of:

        providing a diagnostic program in the wireless data collection device for

diagnosing the operation of the device *(diagnosing or collecting a performance or status*

of a component of the vehicle, Abstract, col. 2, lines 40-65; col. 3, lines 6-58);

        receiving a request to reconfigure the device remotely initiating the diagnostic

program using a communications protocol over a network *(Abstract, col. 2, lines 40-65;*

col. 3, lines 6-58; col. 4, line 59 – col. 4, line 46);

        communicating outputs from the diagnostic program using the communications

protocol to the network *(Abstract, col. 2, lines 40-65; col. 3, lines 6-58; col. 3, line 59 –*

col. 4, line 46; col. 4, line 47 – col. 5, line 5); and

        providing reconfiguring information to a user of the device based upon the

outputs from the diagnostic program *(Abstract, col. 2, lines 40-65; col. 3, lines 6-58; col.*

3, line 59 – col. 4, line 46; col. 4, line 47 – col. 5, line 5).

15.   Claims 8-12 are similar limitations of claims 2-6; therefore, they are rejected

under the same rationale as in claims 2-6.

16.   As to claim 13, Lightner teaches a method for updating a wireless data collection

device, comprising the steps of:

providing a diagnostic program in the wireless data collection device for

diagnosing the operation of the device *(diagnosing or collecting a performance or status*

of a component of the vehicle, Abstract, col. 2, lines 40-65; col. 3, lines 6-58);

receiving a request to update the device remotely initiating the diagnostic

program using a communications protocol over a network *(Abstract, col. 2, lines 40-65;*

col. 3, lines 6-58; col. 4, line 59 – col. 4, line 46);

communicating outputs from the diagnostic program using the communications

protocol to the network *(Abstract, col. 2, lines 40-65; col. 3, lines 6-58; col. 3, line 59 –*

col. 4, line 46; col. 4, line 47 – col. 5, line 5); and

providing updating information to a user of the device based upon the outputs

from the diagnostic program *(Abstract, col. 2, lines 40-65; col. 3, lines 6-58; col. 3, line*

59 – col. 4, line 46; col. 4, line 47 – col. 5, line 5).

17.   Claims 14-18 are similar limitations of claims 2-6; therefore, they are rejected

under the same rationale as in claims 2-6.

Claim Rejections - 35 USC § 102

18.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102(e)

that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

19.   Claims 1-18 are rejected under 35 U.S.C. 102(e) as being anticipated by **Doviak**

et al. US patent no. **6,198,920 B1**.

20.   As to claim 1, Doviak teaches substantially the invention as claimed, including a

method for servicing a wireless data collection device *(Fig. 2, item 52)*, comprising the

steps of:

       providing a diagnostic program in the wireless data collection device for

diagnosing the operation of the device *(Abstract, Figs. 29, 30; col. 9, lines 4-44; col.24,*

lines 49-64);

       receiving a request to service the device remotely initiating the diagnostic

program using a communications protocol over a network *(Abstract, Fig. 25; col. 25,*

lines 7-65; col.27, lines 14-41);

       communicating outputs from the diagnostic program using the communications

protocol to the network *(Abstract, Fig. 25; col. 9, lines 4-44; col.24, lines 49-64; col. 25,*

lines 7-65; col.27, lines 14-41); and

       providing servicing information to a user of the device based upon the outputs

from the diagnostic program *(Abstract, Fig. 25; col. 9, lines 4-44; col.24, lines 49-64; col.*

25, lines 7-65; col.27, lines 14-41; col. 29, line 54 – col. 31, line 19).

21.   As to claim 2, Doviak teaches, wherein the network is the Internet *(col. 38, lines*

9-64).

22.   As to claim 3, Doviak teaches, wherein the information is provided over the

network *(col. 38, lines 9-64)*.

23.   As to claim 4, Doviak teaches, wherein the request to service is received over the network *(col. 38, lines 9-64)*.

24.   As to claim 5, Doviak teaches, wherein the device is a scanning terminal *(col. 30, lines 25-34)*.

25.   As to claim 6, Doviak teaches, wherein the device is an integrated scanning terminal *(col. 30, lines 25-34)*.

26.   As to claim 7, Doviak teaches a method for reconfiguring a wireless data collection device, comprising the steps of:

providing a diagnostic program in the wireless data collection device for diagnosing the operation of the device *(Abstract, Figs. 29, 30; col. 9, lines 4-44; col.24, lines 49-64)*;

receiving a request to reconfigure the device remotely initiating the diagnostic program using a communications protocol over a network *(Abstract, Fig. 25; col. 25, lines 7-65; col.27, lines 14-41)*;

communicating outputs from the diagnostic program using the communications protocol to the network *(Abstract, Fig. 25; col. 9, lines 4-44; col.24, lines 49-64; col. 25, lines 7-65; col.27, lines 14-41)*; and

providing reconfiguring information to a user of the device based upon the outputs from the diagnostic program *(Abstract, Fig. 25; col. 9, lines 4-44; col.24, lines 49-64; col. 25, lines 7-65; col.27, lines 14-41; col. 29, line 54 – col. 31, line 19)*.

27.   Claims 8-12 are similar limitations of claims 2-6; therefore, they are rejected under the same rationale as in claims 2-6.

28.   As to claim 13, Doviak teaches a method for updating a wireless data collection

device, comprising the steps of:

providing a diagnostic program in the wireless data collection device for

diagnosing the operation of the device *(Abstract, Figs. 29, 30; col. 9, lines 4-44; col.24,*

lines 49-64);

receiving a request to update the device remotely initiating the diagnostic

program using a communications protocol over a network *(Abstract, Fig. 25; col. 25,*

lines 7-65; col.27, lines 14-41);

communicating outputs from the diagnostic program using the communications

protocol to the network *(Abstract, Fig. 25; col. 9, lines 4-44; col.24, lines 49-64; col. 25,*

lines 7-65; col.27, lines 14-41); and

providing updating information to a user of the device based upon the outputs

from the diagnostic program *(Abstract, Fig. 25; col. 9, lines 4-44; col.24, lines 49-64; col.*

25, lines 7-65; col.27, lines 14-41; col. 29, line 54 – col. 31, line 19).

29.   Claims 14-18 are similar limitations of claims 2-6; therefore, they are rejected

under the same rationale as in claims 2-6.

Claim Rejections - 35 USC § 102

30.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102(e)

that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

31.   Claims 1-18 are rejected under 35 U.S.C. 102(e) as being anticipated by

Jayanth US patent no. **6,324,854 B1**.

32.   As to claim 1, Jayanth teaches substantially the invention as claimed, including a

method for servicing a wireless data collection device *(Fig. 2, item 34)*, comprising the

steps of:

providing a diagnostic program in the wireless data collection device for

diagnosing the operation of the device *(one component of air-conditioning system, e.g.,*

motor) (Abstract, col. 1, line 16 – col. 3, line 60; col. 3, lines 6-58);

receiving a request to service the device remotely initiating the diagnostic

program using a communications protocol over a network *(Abstract, col. 2, lines 40-65;*

col. 3, lines 6-58);

communicating outputs from the diagnostic program using the communications

protocol to the network *(Abstract, col. 2, lines 40-65; col. 3, lines 6-58)*; and

providing servicing information to a user of the device based upon the outputs

from the diagnostic program *(Abstract, col. 2, lines 40-65; col. 3, lines 6-58)*.

33.   As to claim 2, Jayanth teaches, wherein the network is the Internet *(Abstract, col. 2, lines 40-65; col. 3, lines 6-58)*.

34.   As to claim 3, Jayanth teaches, wherein the information is provided over the network *(Abstract, col. 2, lines 40-65; col. 3, lines 6-58)*.

35.   As to claim 4, Jayanth teaches, wherein the request to service is received over the network *(Abstract, col. 2, lines 40-65; col. 3, lines 6-58)*.

36.   As to claim 5, Jayanth teaches, wherein the device is a scanning terminal *(Fig. 3, item 50)*.

37.   As to claim 6, Jayanth teaches, wherein the device is an integrated scanning terminal *(Fig. 3, item 50)*.

38.   As to claim 7, Jayanth teaches a method for reconfiguring a wireless data collection device, comprising the steps of:

    providing a diagnostic program in the wireless data collection device for diagnosing the operation of the device *(Abstract, col. 2, lines 40-65; col. 3, lines 6-58)*;

    receiving a request to reconfigure the device remotely initiating the diagnostic program using a communications protocol over a network *(Abstract, col. 2, lines 40-65; col. 3, lines 6-58)*;

    communicating outputs from the diagnostic program using the communications protocol to the network *(Abstract, col. 2, lines 40-65; col. 3, lines 6-58)*; and

    providing reconfiguring information to a user of the device based upon the outputs from the diagnostic program *(Abstract, col. 2, lines 40-65; col. 3, lines 6-58)*.

39.   Claims 8-12 are similar limitations of claims 2-6; therefore, they are rejected

under the same rationale as in claims 2-6.

40.   As to claim 13, Jayanth teaches a method for updating a wireless data collection

device, comprising the steps of:

        providing a diagnostic program in the wireless data collection device for

diagnosing the operation of the device *(Abstract, col. 2, lines 40-65; col. 3, lines 6-58)*;

        receiving a request to update the device remotely initiating the diagnostic

program using a communications protocol over a network *(Abstract, col. 2, lines 40-65;*

col. 3, lines 6-58);

        communicating outputs from the diagnostic program using the communications

protocol to the network *(Abstract, col. 2, lines 40-65; col. 3, lines 6-58)*; and

        providing updating information to a user of the device based upon the outputs

from the diagnostic program *(Abstract, col. 2, lines 40-65; col. 3, lines 6-58)*.

41.   Claims 14-18 are similar limitations of claims 2-6; therefore, they are rejected

under the same rationale as in claims 2-6.

42.   Further references of interest are cited on Form PTO-892, which is an

attachment to this action.

43.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Hai V. Nguyen whose telephone number is 703-306-

0276. The examiner can normally be reached on 6:00-3:30 Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Jack Harvey can be reached on 703-305-9705. The fax phone number for

the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

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For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Hai V. Nguyen
Examiner
Art Unit 2142

JACK B. HARVEY
SUPERVISORY PATENT EXAMINER